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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,538	06/15/2001	Alexander Kalnitsky	60305-307201	8283

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EXAMINER

FARAHANI, DANA

ART UNIT

PAPER NUMBER

2814

DATE MAILED: 01/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/882,538	KALNITSKY ET AL.
	Examiner Dana Farahani	Art Unit 2814

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 05 November 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-5,7-12,14-21 and 23 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 1-5,7,18-21 and 23 is/are allowed.

6) Claim(s) 8,9,12 and 14 is/are rejected.

7) Claim(s) 10,11 and 15-17 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 21 March 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10. 6) Other: _____

DETAILED ACTION

Claim Objections

1. Claim 10 is objected to because of the following informalities: it depends upon itself. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in–
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claim 8 rejected under 35 U.S.C. 102(e) as being anticipated by Sato (U.S. Patent 6,436,781).

Regarding claims 8 and 14, Sato discloses in figure 3B a semiconductor substrate 1 having a buried collector layer 9; multiple layers above the collector region; an emitter window mask above the multiple layers, as can be seen in the figure; a doped collector region, 12 of figure 6, with the width equal to the emitter window mask width (see column 8, lines 46-51); a horizontal etch region of layer 7 (see column 7, lines 59 and 60), wherein layer 7 is polysilicon, and the etching extends a distance greater than the thickness of layer 7; base regions 10 and 11 above the collector in the

horizontally etched area; and an emitter region 14 of figure 6 above the base, wherein the dimension of the base region is wider than a dimension of the collector and the emitter.

Regarding claim 9, the dimensions of the horizontally etched region determine that the dimensions of the base region are wider than the collector and the emitter (see figure 4A; and column 8, lines 39-44).

Regarding claim 12, the collector doped with phosphorous (see column 8, line 49).

Allowable Subject Matter

4. Claim 1-5, 7, 18-21 and 23 are allowed.
5. Claims 10, 11 and 15-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. The following is a statement of reasons for the indication of allowable subject matter:

The primary reason for indication of the allowability of claims 1-8, 18-21 and 23 is the inclusion therein of the limitations of providing horizontal etching and wet etching of the layers recited in claims 1, 18, and 21, among other limitations in those claims.

The primary reason for indication of the allowability of claims 10 and 11 is the limitations of the nitride layer above the surface oxide and the polysilicon layers, along with other limitations in those claims.

The primary reason for indication of the allowability of claims 15-17 is the limitation of horizontally etched region allows the space between active and inactive base, emitter and collector regions to be controlled.

Product-by-Process Limitations

While not objectionable, the Office reminds Applicant that "product by process" limitations in claims drawn to structure are directed to the product, *per se*, no matter how actually made. *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also, *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessmann*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wethheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); *In re Marosi et al.*, 218 USPQ 289; and particularly *In re Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final product *per se* which must be determined in a "product by process" claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or otherwise. Note that applicant has the burden of proof in such cases, as the above case law makes clear. Thus, no patentable weight will be given to those process steps which do not add structural limitations to the final product.

For example, in claim 14, wet chemical silicon etch and plasma etching are considered methods of forming the base region and not limitation of the final product. Therefore, such limitations are given no patentable weight.

Response to Arguments

7. Applicant's arguments with respect to the previously rejected claims have been considered but are moot in view of the new grounds of rejection.

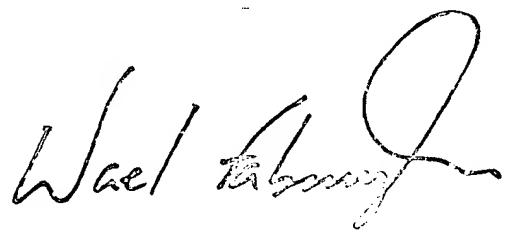
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dana Farahani whose telephone number is (703)305-1914. The examiner can normally be reached on M-F 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on (703)308-4918. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9318 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

Dana Farahani
January 17, 2003



Wael Fahmy

SUPERVISORY PRIMARY EXAMINER
TECHNOLOGY CENTER 2800